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10/505,235	08/19/2004	Nicholas Arthur Scott	RR-569 PCT/US	3884

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EXAMINER

AUGUSTIN, EVENS J

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/505,235

Applicant(s)

SCOTT, NICHOLAS ARTHUR

Examiner

Evans Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-15 and 17-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-15 and 17-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This is in response to an amendment file on 09/01/2006 for letter for patent filed on 8/19/2004. In the amendment, claims 1-2 have been amended. Claims 29-32 have been added. Claims 1-3, 5-15, 17-32 are pending in the letter.

Response to Arguments

1. The United States Patent and Trademark Office has fully considered the applicant's arguments filed on 09/01/2006, but has not found those arguments to be persuasive.

It appears that applicant is arguing is arguing limitations that are in the preamble. In response to applicant's arguments, the recitations of: 1- An article token selection device that displays or identifies articles for sale; 2) A non-validated token is issued upon activation of the article token selection device; 3) The non-validated token relates to a particular article that is selected at the article token selection device; 4) The non-validated token is provided with information relating to a unique token number and/or article type when it is issued by the article token selection device; 5) The non-validated token is issued by a printer that is controlled by the article token selection device, have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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The aspect of a *dispensing unit* appears in the preamble of claims 1-2 and 29. The argument for the lack of requirement for “*validated token provided by said checkout unit is a token which substitutes or supplements the non-validated token said validated token being issued by the checkout unit from a token dispenser from a token printer or from a supply of pre-made non-alterable reusable revalidatable and machine-readable tokens*” in claim 2, is not accorded any patentable weight because the language is not part of the structural limitations of the claims.

Status of Claims

2. Claims 1-3, 5-15, 17-32 have been examined.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful **process, machine, manufacture, or composition of matter, or any new and useful improvement thereof**, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. The independent claims 1-2 and 29 are directed to a system that comprises of **both a process (to provide a customer with a non-validated token...) and machine (checkout unit having a device...)**, and therefore rendered the claims/invention to be non-statutory.

Claim Rejections - 35 USC § 112

1. Claims 1-2 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of the states:

A method or system "for the sale of consumer goods, the system being designed to provide a customer with a non-validated token that represents an article of merchandise, said article being to be paid for by the customer at a checkout unit when the non-validated token is checked by said unit, said checkout unit having a device for communicating with an article dispensing device, providing the article dispensing device with a first transaction code after the article has been paid for, and providing the customer with a validated token which carries a second transaction code, said validated token being to be used to obtain the purchased article from the article dispensing device with the aid of a comparator device within the article dispensing device which compares the second transaction code on the validated token as entered in the comparator device with the first transaction code which has been communicated by said communication device, and said article dispensing device delivering the article when there is a defined code correspondence, said non-validated token carrying information that is related to a unique token number and the article type, and said unique token number provided on the non-validated token constituting said second transaction code when the token is made into a validated token at the check-out unit, wherein the non-validated token is a part of or consists of packaging for the article that is to be dispensed and is issued by a printer controlled by an article token selection

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panel device that displays articles for which a related non-validated token can be printed on activation of the panel, wherein said unique token number when issued by said article token selection panel device is selected from the group consisting of: ... It is not clear of what the metes and bound of the invention are, by reading the above passage. Although an essential purpose of the examination process is to determine whether or not the claims define an invention that is both novel and non-obvious over the prior art, another essential purpose of patent examination is to determine whether or not the claims **are precise, clear, correct, and unambiguous.**

The essential inquiry pertaining to this requirement for precision, clarity and un-ambiguity is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. The above claim languages are analyzed in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing the claims for compliance with 35 U.S.C. 112, second paragraph, the USPTO has considered the claims as a whole and determined that the claims do not apprise one of ordinary skill in the art of its scope and, therefore, do not serve the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001).

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Additionally, it appears that applicant is arguing limitations that are in the preamble. In response to applicant's arguments, the recitations of: 1- An article token selection device that displays or identifies articles for sale; 2) A non-validated token is issued upon activation of the article token selection device; 3) The non-validated token relates to a particular article that is selected at the article token selection device; 4) The non-validated token is provided with information relating to a unique token number and/or article type when it is issued by the article token selection device; 5) The non-validated token is issued by a printer that is controlled by the article token selection device, have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-3, 5-15, 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Planke (U.S 5902984), in view of Ranieri (U.S 6281886).

As per claims 1-3, 5-15, 17-28, Planke discloses an invention relates to a system for the sale of consumer goods, where the purchaser of an article at the place of purchase collects one or more non-validated card symbols of the article, where data carried on the symbol of the article are read and registered, where such data are converted to a price for the article which is paid by the purchaser of the article, where the purchaser of the article receives a validated symbol of the article, and where the article is dispensed to the purchaser at a dispensing location in return for his/her depositing the validated symbol of the article. The computer system includes:

- An optically readable card with data containing the item to be purchased in the form of a serial number (column 2, lines 12-16). The uniqueness of the serial number implies that is generated serially.
- A **merchandise dispensing unit** to dispense merchandise in accordance with the **corresponding serial number (serially generated transaction code)**(column 2, lines 17-18)
- A checkout unit (cash register), where the optically readable card is validated (column 2, lines 25-30)
- A comparator unit to reconcile the information received by dispensing unit (column 4, lines 26-29)
- The type of information in the card can be a bar code and magnetically readable code (column 3, lines 42-43), or **EAN code** (column 5, lines 41)

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- After the card is validated at the check out unit, the validation signal is sent to the merchandise dispenser to be able to recognize and accept the validated card before dispensing the merchandise (column 4, lines 21-50, column)
- The ability to transmit the validation signal from the check out unit to the merchandise dispenser via a connection (column 4, lines 44-45, figure 1, items 9 and 15)
- The check out unit includes a scanner or a bar code reader (column 3, lines 49-51)

Planke did not explicitly describe a method/system in which the initial non-validated card/token/ticket is dispensed by a mechanism such as dispensing unit. However, Ranieri describes an invention that relates to an information handling system by way of touchscreen terminals. The invention more particularly relates to the entering, displaying and processing of text of various human languages consisting of multi-byte characters when the text is entered by means of a touchscreen terminal keyboard into a programmed computer system (column 1, lines 5-12). Particularly, Ranieri's invention is applicable to self-service kiosks to provide the plurality of functions required in such an application, including touchscreen, speaker, digital video/audio, magnetic stripe/chip card reader, receipt printer, statement printer, laser printer, ticket printer, bankbook printer, PIN pad generic device (column 4, lines 63-67, column 5, lines 1-7).

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to combine Planke's invention of a merchandise dispenser that validates/reads validation card/token/ticket with Ranieri's invention that relates to the entering,

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displaying and processing of text of various human languages consisting of multi-byte characters, when the text is entered by means of a touchscreen terminal keyboard into a programmed computer system.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the two inventions because **(motivation)** it would provide for self-service terminals/kiosks which include touchscreens for entering into a computer system text and information consisting of multi-byte characters or multiple multi-byte characters of human languages as well as single byte character languages (column 3, lines 27-32).

Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Prior art should be considered in its entirety, including disclosures that are not referenced in this office action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on 10am - 6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571)272-6779.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin
November 12, 2006
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 11/13/06
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